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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
00-106

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on July 17, 2007

Signature _____

Typed or printed name Veronika S. Leliever

Application Number	Filed
09/993,228	November 14, 2001

First Named Inventor: Raymond J. Mueller

Art Unit	Examiner
3622	Yehdega Retta

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 50,252.
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Michael Downs 50252/
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July 17, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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REQUEST FOR REVIEW

A. INTRODUCTION

Claims 1, 6, 7, 9, and 11-26 are pending and rejected.

Appellants respectfully request Pre-Appeal Brief Review of the rejections set forth in the Final Office Action mailed April 17, 2007. No amendments are being filed with this request and this request is being filed with a Notice of Appeal. Review is requested for the reasons set forth below.

B. SECTION 112 ¶ 2 REJECTION: INDEFINITENESS

Claim 11 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which we regard as the invention. Appellants respectfully traverse the Examiner's Section 112 ¶ 2 rejection of Claim 11.

Appellants respectfully note that Claim 11 recites in which determining the offer for the customer is further based on the amount of sales tax (emphasis added), and clearly refers to the same offer recited in Claim 9. It is clear from the plain language of Claims 9 and 11, and consistent with the Specification, that no specific order of determining the difference or determining the sales tax is required in Claim 11 to determine an offer for the customer. The Specification discloses that sales tax may be taken into account in determining a round-up amount, but does not require any particular order, or any specific relationship between the recited difference and an amount of sales tax. See, e.g., Specification, page 10, lines 18-20. Claim 11 recites, with reasonable clarity to one of ordinary skill in the art when considered (as required) in light of the Specification, that an offer may be determined based on a difference and an amount of sales tax, without requiring any particular manner or order of determining either the difference or the amount of sales tax.

Accordingly, Appellants respectfully request that the Section 112 ¶ 2 rejection of Claim 11 be reconsidered and withdrawn.

C. SECTION 103(A) REJECTIONS

Claims 1, 6, 7, 9, and 11-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Heads I win ("Heads I win, tails you lose," *The Economist*, June 13, 1992, p. 74) and Bieganski (U.S. Patent No. 6412012). Appellants respectfully traverse the Examiner's Section 103(a) rejection.

As explained in Appellants' previous Response filed August 23, 2006, even if Heads I win generally describes circumstances in which a purchase price would be rounded either up or down (i.e., if "customers chose to use Mr. Rossides's system

for payment"), there is no hint or suggestion of how *an offer* could be determined based on either a round-up amount (Claims 1, 6, and 7) or a difference between a transaction total and a next-highest dollar amount (Claim 9).

Appellants submit that there is no teaching, suggestion, or motivation, or other apparent reason that has been established by substantial evidence as supported by either the references relied upon (Bieganski or Heads I win) or by other evidence made of record, to combine the alleged teachings in the manner proposed by the Examiner. The Examiner appears to be suggesting that it would have been obvious to offer an additional product (recommended by a system like Bieganski) to a customer in the circumstance where the Heads I win system randomly determined to round up the price. In other words, the customer would get more for the rounded up price. If that is the suggested modification, Appellants do not agree the modification is obvious. To the contrary, it would be undesirable. Modifying the Heads I win system in the manner suggested by the Examiner would fatally destroy the principle of operation of the Heads I win system, which is to ensure based on "iron laws of probability" "that both parties get a fair deal in the long run." The fundamental principle of operation of the Heads I win system is to round a particular purchase up or down, and that principle would be fatally violated if additional items were introduced. If the Heads I win system is randomly rounding down prices, it must be able to make up for that loss of revenue by rounding up prices without giving away any additional products or other valuable consideration. Otherwise, the (modified) Heads I win system would be giving away more by rounding down than it would recoup by rounding up (and giving away more items for the rounded up price).

The Examiner also asserts that Heads I win teaches "determining an offer (to round up the total cost of the goods purchased) based on round-up amount (total price rounded up or rounded down) based on the result of two numbers added."

Heads I win does not teach an offer "to round up the total cost of the goods purchased." Instead, it teaches allowing the customer to participate in a payment system that will result, based on a random determination, in the price being either (i) rounded up or (ii) rounded down. Contrary to the Examiner's finding, the customer in the Heads I win system is not presented with any option to have a price rounded up specifically.

Regardless, Heads I win does not teach or suggest determining any offer based on any round-up amount, or hint at how an offer could be so determined. Appellants do not understand the Examiner's finding on this point: What is the "offer" to which the Examiner is referring as being "based on round-up amount"? Heads I win describes that whether a price is rounded up or down is only based on: "If this third [randomly-determined] number is less than or equal to the amount of

change in the price" (e.g., if a purchase is $1.46, the amount of change in the price is "46"). No offer is determined based on either a round-up amount or a difference between a transaction total and a next highest dollar amount greater than the transaction total. The Heads I win system does not mention any round-up amount or difference, much less determining an offer based on any such feature. For instance, Heads I win does not even suggest that offering to the customer the chance to participate in the alternative payment system has anything to do with the price, much less any round-up amount (Claims 1, 6, 7) or the difference calculated in Claim 11. Finally, to the extent that the Examiner is suggesting that the customer in the Heads I win system is given an offer to pay a rounded-up total price, Appellants respectfully disagree. Once the customer agrees, in the Heads I win system, to participate in the random determination, the customer must accept or reject the new price (rounded up or down), so the customer is never offered a rounded up or rounded down price (only the option to participate in the system and accept the random consequence). Were it otherwise, the "iron laws of probability" would not "ensure that both parties get a fair deal in the long run."

Further, with respect to independent Claim 9, Heads I win does not describe calculating a difference between a transaction total and a next-highest dollar amount greater than the transaction total. It simply describes (in some circumstances) the customer paying the next-highest dollar amount—the actual difference is never calculated. The Examiner's assertion that Heads I win teaches "the difference between for example $1.46 and $2.00" is not supported by the reference. Appellants note that such a teaching is not inherent, either. If the Heads I win system decides (at random) to round up to $2, it is not necessary to calculate the difference between $1.46 and $2; the price could simply be re-set to $2. As explained above, regardless, any such difference has nothing to do with any offer provided in the Heads I win system.

Appellants submit that nothing in Bieganski or Heads I win suggests that selection or determining of an offer has anything to do with a price of an order, a round-up amount, or a difference between a transaction total and a next-highest dollar amount greater than the transaction total.

For at least these reasons, Appellants submit that the Examiner has not established a prima facie case of obviousness for any of independent Claims 1, 6, 7, or 9 (or dependent Claims 11-26), and further submit that no combination of the cited Heads I win and Bieganski render any claim obvious. The Examiner's reconsideration and withdrawal of the Section 103(a) rejections are respectfully requested.

D. ADDITIONAL COMMENTS

Appellants' silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an unrebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, Appellants need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.